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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,642	11/06/2001	Kevin C. Hutton	GOLDENH.006A	9965

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EXAMINER

GOTTSCHALK, MARTIN A

ART UNIT PAPER NUMBER

3626

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,642

Applicant(s)

HUTTON ET AL.

Examiner

Martin A. Gottschalk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 06/06/05. Claims 1-18 are currently pending. Claims 1 and 11 are amended from the original; claims 2-10 are as per the original; claims 13-18 are new.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clawson (US Pat# 6,106,459) in view Barber et al (US Pat# 4,858,121, hereinafter Barber).

A. As per claim 1, Clawson discloses an integrated emergency medical transportation database system (Clawson; col. 3, lines 31-34 and 65-67) comprising:
a medical emergency database configured to store at least clinical encounter information, (Clawson; col. 4, lines 2-5); patient demographic data (Clawson; col. 7, lines 25-31); and transport information (Clawson; col. 4, line 62 through col. 5, line 3).
Clawson fails to expressly disclose

a billing modifier module, wherein the billing modifier module
accesses a stored clinical encounter location stored in the medical
emergency database and
compares the clinical encounter location to a list of geographic areas, and
wherein the result of the comparison causes billing modifiers to be
determined and applied to the medical charges associated with the medical
emergency.

However, this feature is well known in the art, as evidenced by Barber. Barber discloses a system and method for medical payments which includes a patient billing program (Barber; FIG. 6 item 276). The system collects data associated with a plurality of objects, including physician identity (Barber; col. 6, lines 29-32), wherein a physician's office is considered by the Examiner to be a type of "clinical encounter location."

Furthermore, for the purpose of validation of physician identification, Barber teaches a comparison between newly incoming physician identification information, considered by the Examiner to include a ZIP code as part of the clinical encounter location, and data in a prerecorded physician's file (Barber; col. 6, lines 29-45. Note that the passage is directed to claim processing. The Examiner considers a payment address--i.e. the physician's address--to be part of the physician's file, and the address would include a ZIP code--i.e. a list of geographical areas.).

As per the application of billing modifiers, the system of Barber accommodates payments for portions of a total bill, wherein the system determines the balance due and

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generates a modified bill (Barber; col. 3, line 60 through col. 4 line 6), i.e. validation of the physician's identification causes the modified patient charges to be determined and applied to create a partial bill.

One having ordinary skill in the art at the time of the invention would have found it obvious to combine the billing features disclosed by Barber within the emergency medical database disclosed by Clawson. The motivations for this combination would have been to i) verify the accuracy of billing information with respect to physician identity (Barber: col 2, lines 3-6), and to ii) increase the speed of payment to physicians or other providers (Barber: col. 2, lines 32-36).

B. As per claim 2-10 and 12, they are unamended and are thus rejected on the same grounds provided in the previous Office Action.

C. As per claim 13, Clawson discloses the system of claim 1, wherein the clinical encounter information is indicative of medical transportation (Clawson, col 4, ln 65 to col 5, ln 3).

D. As per claims 11 and 14-18 it is a method claim which repeats the same limitations of claims 1, 13, 3-5, and 7, the corresponding system claim, as a series of process steps as opposed to a collection of elements. Since the collective teaching of Clawson and Barber disclose the structural elements that constitute the system of claims 1, 13, 3-5, and 7, it is respectfully submitted that they perform the underlying

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process steps, as well. As such, the limitations of claims 11 and 14-18 are rejected for the same reasons given above for claims 1, 13, 3-5, and 7.

The motivation for incorporating the features of Barber within the system of Clawson is as given above in the rejection of claim 1, and is incorporated herein.

Response to Arguments

4. Applicant's arguments in the response filed 6/06/05 have been fully considered by they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the REMARKS section of the response filed 6/6/05.

A. On page 6, paragraph 3 of the response, Applicant submits that the Barber reference "does not show any connection of the result of the comparison to cause billing modifiers to be determined and applied to the medical charges."

In response, the Examiner points out that the partial (i.e. modified) bill will only be generated once the physician's identity is validated (see the rejection for claim 1 above), i.e. the generation of the bill is caused by the validation of the physician's identity.

B. On page 6, paragraph 4 of the response, Applicant points out that the ZIP code file explicitly disclosed by Barber refers to the patient's ZIP code, and not to the physician.

In response, the Examiner acknowledges this point, but respectfully submits that the physician's file disclosed by Barber will contain the physician's ZIP code at least for

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claim payment purposes (see the rejection for claim 1 above). The Examiner further points out that where a patient lives could be a clinical encounter location (and would thus be represented by a ZIP code), particularly in an emergency situation (see the rejection for claim 13 above).

C. On page 7, paragraph 1 of the response, Applicant states that because the Clawson reference "has nothing to do with billing", one of skill in the art would not have been motivated to combine it with the Barber reference which teaches a billing system.

In response, the Examiner confirms that no claim is being made that the Clawson reference fully anticipates the current invention, but rather it is the combination of the Clawson and Barber references which would have made the current invention obvious to one of ordinary skill in the art at the time of the invention, as stated in the rejection for claim 1.

In particular, the Examiner points out that the part of Applicant's invention taught by Clawson is the emergency medical transportation system aspect, and that it is the combination of this reference with the billing system of Barber that would have made the current invention obvious to one of ordinary skill in the art at the time of the invention, for the motivation provided in the rejection of claim 1.

D. Also on page 7, paragraph of the response, Applicant points out that the specific motivation to combine references provided for claim 1 is "...not claimed by Applicant."

This implies that it is inappropriate to combine the references unless the features of the motivation are claimed by Applicant.

In response to this argument, the Examiner points out that mere recognition by Applicant of another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5.

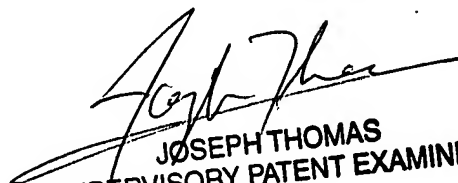
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MG

MG
08/19/2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER